



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:  
MARK R. DUCHOW

Serial No.: 09/682,876

Filed: October 26, 2001

For: SYSTEM AND METHOD FOR  
PROVIDING ELECTRONIC VOUCHERS

Group Art Unit: 3622

Examiner: James W. Myhre

Atty. Dkt. No.: 05012.0003.CNUS01

DECLARATION OF MARK R. DUCHOW UNDER 37 C.F.R § 1.131

Assistant Commissioner for Patents  
Washington, D.C. 20231

I, Mark R. Duchow, hereby declare:

1. I am over the age of eighteen years, and, except for matters identified as being based on information and belief, have personal knowledge of the matters stated herein. If called upon to do so, I would testify as a witness to these matters.

2. All statements made herein on the basis of personal knowledge are true, and all statements made herein on the basis of information and belief are believed to be true.

3. I am married with five children all under the age of sixteen.

4. I am a part owner of Duchow's Boat Center, which has retail stores in Oconomowoc, Wisconsin; and Fox Lake, Illinois. I am employed full time as a manager of these stores.

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**GROUP 3600**

5. I am also the President and owner of MRD Holding, LLC, the assignee of the above-identified patent application.

6. I have no formal training in software development, computer networking, or website design.

7. I am the sole inventor named in the patent application referenced above and the sole inventor of the subject matter described and claimed therein. I have reviewed and understand the contents of the above-identified application and the Office Action dated April 2, 2003.

8. I understand that claims 2, 3, 5/2, 5/3, 6/2, 6/3, 7/2, 7/3, 8/2, 8/3, 9/2, 9/3, 10/2, 10/3, 11/10/2, 11/10/3, 14, 15, 17/14, 17/15, 18/14, 18/15, 19/14, 19/15, 20/14, 20/15, 25/14, 25/15, 26/14, 26/15, 29/14, 29/15, 32, 33, 39, 44, 45, 53, and 54 are rejected under 35 U.S.C. 102(e) as being anticipated by Awada et al (2002/00657143) (“Awada”); claims 38 and 56-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Awada; claims 4, 5/4, 6/4, 9/4, 10/4, 11/10/4, 12, 16, 18/16, 20/16, 21, 24, 25/16, 25/24, 26/16, 26/24, 29/16, 29/24, 31, 34, 36, 47, 48 and 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Awada in view of Cupps et al (5,991,739); claims 7/4, 8/4, 17/16, 19/16, 27, 28, 30, 49, and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Awada in view of Cupps as applied to claims 4, 16, 24, and 47 above, and further in view of Scroggie et al (6,185,541).

9. The above referenced patent application is a continuation of U.S. patent application no. 09/822,450 (“the ‘450 application”), which has a filing date of March 30, 2001. The subject matter claimed in the above referenced patent application is

sufficiently described in the '450 application, and thus, the effective filing date of the subject application is March 30, 2001.

10. The remarks and attached exhibits which follow establish that the subject matter of the rejected claims was conceived prior to the November 29, 2000 filing date of the Awada patent and diligently reduced to practice by March 30, 2001.

11. Prior to November 29, 2000, my conception the invention as described and claimed in the subject U.S. patent application had been completed in this country, as evidenced by the following exhibits. Each will be described in greater detail in subsequent paragraphs.

- a) The Boatcash.com website was constructed by Meandaur, Inc., a third party software developer, according to my specifications, as evidenced by the Declaration of Jon Schepke attached hereto as Exhibit 1. The Boatcash.com website included a memory for storing buyer, dealer, and product information. It had pages for displaying information about recreational boats. The website included a database of information on various boat models. A buyer could access the website over the Internet, select a particular boat brand and model, display information about boats, enter buyer information, such as name, address (including zip code), email address, and phone number. The buyer could also receive via email an electronic voucher for a cash discount on a selected boat. The amount of the discount depended on the boat selected by the buyer. The buyer could download the voucher, print it out, and then redeem it at one of Duchow's Boat Centers. The voucher included restrictions so that it was only

redeemable at a Duchow's Boat Center for the selected boat model. The voucher also included an expiration date so that it could only be used during certain periods.

- b) I designed a promotional website that could be used to offer vouchers for cash discounts over the Internet without offending boat dealership agreements and marketing territories, as evidenced by the Declaration of Jon Schepke (Ex. 1) and the Declaration of Bruce Sargent, attached hereto as Exhibit 2. The website was a modified version of the Boatcash.com site that included a database of boat dealerships and a software program that would select the dealer covering the territory of the buyer by comparing the zip code input by the buyer to the dealership locations identified in the dealer database. The website software would download the electronic voucher to the buyer. The voucher indicated the location of the nearest dealer and the amount of the discount corresponding to the selected boat. A buyer could print out the voucher and take it to the local dealer for redemption. The voucher included restrictions so that it could only be redeemed at the local dealer during a sales period.

12. Shortly after November 29, 2000, the invention as described and claimed in the subject U.S. patent application had been diligently reduced to practice in this country, as evidenced by the following exhibits. Each will be described in greater detail in subsequent paragraphs.

- a) Planning and construction of the Glastron Internet boat sale website commenced prior to November 29, 2000, as evidenced by the Declaration

of Jon Schepke (Ex. 1). The Glastron website included the features and functions described above in paragraph 11(b) and claimed in the subject patent application. As stated in the Schepke Declaration, it took approximately four months to build and test the website and its associated databases. It was completed by early April 2001. Given the complexity of the software development and the number of Glastron dealers involved in the database development, the four month development period was reasonable. In addition, the development period between November 2000 and April 2001 included the major holidays of Thanksgiving, Christmas, and New Years.

- b) On March 30, 2001, U.S. patent application no. 09/822,450 (“the ‘450 application”) was filed. The ‘450 application fully described the invention claimed in the subject patent application, and was thus a constructive reduction to practice of the claimed invention on March 30, 2001. As evidenced by the invoices attached hereto as Exhibit 3, I retained the law firm of Quarles & Brady in December 2000 to prepare and file the ‘450 application. As indicated by the dates in the invoices, counsel diligently prepared and filed the ‘450 application.

12. In April 2001, Glastron, a boat manufacturer, used the electronic voucher system covered by the subject patent application for a five-day Internet promotional sale of its boats within the U.S.

13. I am aware that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. § 1001).

I declare under penalty of perjury that the foregoing is true and correct. Executed  
on this 6<sup>th</sup> day of MAY, 2003 at OCONOMOWOC, WI.

  
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MARK R. DUCHOW